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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,806	05/29/2001	Sean F. Walsh	18459-003	6150

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FAEGRE & BENSON LLP
 Attn: PATENT DOCKETING
 2200 WELLS FARGO CENTER
 90 SOUTH 7TH STREET
 MINNEAPOLIS, MN 55402-3901

EXAMINER

CHIANG, JACK

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 10/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,806

Applicant(s)

WALSH, SEAN F.

Examiner

Jack Chiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004 and 22 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 6-13 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 14 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

RESTRICTION

1. The restriction dated on 06-16-04 is made final. Claims 1-5, 14 and 16 are examined, claims 6-13 and 15 are withdrawn from further consideration, see comments in the argument section.

CLAIMS

Double Patenting Rejection

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6246766. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed phone supporting shelf having top side, concave slanted underside, and the ridges are all found in the patent above.

Art Rejection

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5, 14 and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Hill (US 5678793) in view of Ray (US 3956600).

Regarding claim 1, Hill shows:

An elongated shelf (22) which has a thickness between a top side (32b) as a support surface and an underside (32a) which provide an engagement surface for a belt clip (62, 66) of an appliance (60) which is generic for the phones.

Hill differs from the claimed invention in that it does not show that the shelf (22) having a thin (or beveled) surface between thick outer edges.

However, Ray teaches providing a shelf (3) having a thin (or beveled) surface between thick outer edges (see 3 in fig. 2).

Hence, the concept of supporting the phone is well taught by Hill, it would have been obvious for one of ordinary skill in the art to modify Hill's shelf with a thin surface between thick outer edges as taught by Ray, such that the modification would function efficiently, effectively and reliably to removably support the phone (col. 1, lines 15-16 in Ray)

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Regarding claim 14, Hill shows:

An elongated, substantially planar shelf (22) which has a thickness between a top side (32b) comprising a telephone support surface extending between a proximal end (50) and a distal end (42), the shelf (22) having outer edges (34a, b), and a surface for a belt clip (62, 66) of an appliance (60) which is generic for the phones.

Hill differs from the claimed invention in that it does not show that the shelf (22) having a thin (or beveled) surface between thick outer edges.

However, Ray teaches providing a shelf (3) having a thin (or beveled) surface between thick outer edges (see 3 in fig. 2).

Hence, the concept of supporting the phone is well taught by Hill, it would have been obvious for one of ordinary skill in the art to modify Hill's shelf with a thin surface between thick outer edges as taught by Ray, such that the modification would function efficiently, effectively and reliably to removably support the phone (col. 1, lines 15-16 in Ray)

Regarding claim 16, Hill shows the steps of:

Sliding an appliance (60) which is generic for the phones on a top surface of an elongated shelf (22) which has a thickness between a top surface (32b) and a bottom surface (opposite to 32b), including sliding the clip (62, 66) under a distal end (42) between outer edges (34a, b).

Hill differs from the claimed invention in that it does not show that the shelf (22) having a thin (or beveled) surface between thick outer edges.

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However, Ray teaches providing a shelf (3) having a thin (or beveled) surface between thick outer edges (see 3 in fig. 2).

Hence, the concept of supporting the phone is well taught by Hill, it would have been obvious for one of ordinary skill in the art to modify Hill's shelf with a thin surface between thick outer edges as taught by Ray, such that the modification would function efficiently, effectively and reliably to removably support the phone (col. 1, lines 15-16 in Ray)

Regarding claims 2-5, Hill shows:

The length of the shelf (22) can be two times the width, or in any dimensions without change the basic concept of the Hill reference;

The ridges (34a, 34b);

The notch (42, see notch in fig. 6); and

The stem (supporting 44a-b).

ARGUMENT

6. In response to the remarks filed on 07-22-04, applicant cited some portion of MPEP and argues that there is no burden for searching all claims. First, most of the original claims are substantially amended, and new claims are also added. If there is no difference among the different groups of claims, why would applicant need that many groups of claims? The subject matter, and the burden for search, has been changed due to the amendment, therefore, restriction is needed.

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In response to the remarks filed on 04-02-04, the 102 rejection has been withdrawn. Argument is answered in the 103 rejection above. See comments above.

7. Applicant's arguments with respect to claims 1-5, 14 and 16 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

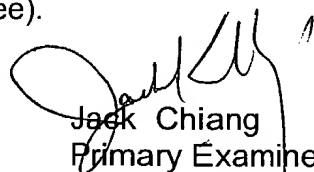
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jack Chiang
Primary Examiner
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